

patenting over claims 1-32 of the same patent. Finally, claims 1-29 are rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,643,581 to Mougine et al. in view of U.S. Patent No. 5,125,486 to Dunne et al. For the reasons set forth below, Applicants request that the Examiner reconsider and withdraw these rejections.

II. Same Invention-Type Double Patenting

The Examiner rejected claims 3, 17, 18, and 19 for same invention-type double patenting over claims 3-6 of Sturla et al. Office Action at 2. The Examiner implies that the claims are coextensive in scope, but gives no basis for this assertion. *Id.* Applicants respectfully submit that the rejected claims are not coextensive in scope with claims 3-6 of the Sturla et al. patent, and therefore no same invention-type double patenting exists.

Same invention-type double patenting exists between two claims only if the claim in the application cannot be literally infringed without literally infringing the claim in the patent, and vice versa. See MPEP § 804; *In re Vogel*, 422 F.2d 438, 440 (C.C.P.A. 1970). While exact literality is not required, the claims must be coextensive in scope. *Id.*

In the present case, the Examiner has asserted that claims 3 and 17-19 of the present application are coextensive in scope with claims 3-6 of the Sturla et al. patent. However, the Examiner has overlooked the fact that claims 3-6 of the Sturla et al. patent each recite that "the (1) at least one compound is different than the (2) at least one diol." Such a limitation is not present in the rejected claims. It is therefore possible for the present claims to be literally infringed by a device comprising a polycondensate while the same device would not infringe the cited claims of the Sturla patent. The claims

therefore are not coextensive in scope. Applicants respectfully request withdrawal of the rejection of these claims for same invention-type double patenting.

III. Obviousness-Type Double Patenting

The Examiner also rejected claims 1-29 for obviousness-type double patenting over claims 1-32 of the Sturla et al. patent. Office Action at 2-3. Without commenting on the merits of the Examiner's rejection, and solely in an effort to further prosecution of this application, Applicants submit herewith a Terminal Disclaimer over the Sturla et al. patent. Applicants respectfully submit that such a Terminal Disclaimer overcomes the Examiner's obviousness-type double patenting rejection, and therefore request its withdrawal. Applicants reserve the right to petition for withdrawal of the Terminal Disclaimer should the claims be substantially amended later in prosecution.

IV. Obviousness Rejection over Mougin et al. in view of Dunne et al.

The Examiner rejected claims 1-29 as obvious over Mougin et al. in view of Dunne et al. Office Action at 3-4. Mougin et al. is said to disclose cosmetic compositions containing a multiblock polycondensate containing a polysiloxane block and a polyurethane and/or polyurea block in an organic solvent. Id. at 4. Dunne et al. is cited as teaching the inclusion of a cosmetic composition in an aerosol container. Id. The Examiner concludes that the combination of these references render the rejected claims obvious. Id.

Applicants respectfully disagree with the Examiner's conclusion and traverse this rejection. As the Examiner is aware, a prima facie case of obviousness requires, *inter alia*, that the cited art teach or suggest each and every element of the rejected claims. See *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970). The Examiner has cited no art which teaches or suggests all elements of claims 1-29 of the present application.

Specifically, neither Mouglin et al. or Dunne et al. teach or suggest that the polycondensate be made up of an arrangement of blocks where the blocks are obtained from: (1) at least one compound with two active hydrogen atoms per molecule; (2) at least one diol containing at least one functional group chosen from acid radicals and salts thereof; and (3) at least one isocyanate chosen from di- and poly-isocyanates. Nor do the references teach or suggest a ratio of propellant to organic solvent of 1.5:1, as recited in the present claims.

For at least these reasons, Applicants respectfully submit that the Examiner has failed to set forth a prima facie case of obviousness against the currently pending claims. The cited references simply do not teach or suggest each and every element of the claims, as required by law. Applicants therefore request that the Examiner withdraw the rejection under § 103(a) and allow the pending claims.

V. Conclusion


In view of the foregoing remarks and the concurrently submitted Terminal Disclaimer, Applicants submit that the claimed invention is not double patented or rendered obvious in view of the prior art references cited against this application. Applicants respectfully request the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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